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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/441,723	11/16/1999	JENNIFER L. HILLMAN	PF-0430-1-DI	4924

27904 7590 07/16/2002

INCYTE GENOMICS, INC.  
3160 PORTER DRIVE  
PALO ALTO, CA 94304

EXAMINER

DAVIS, NATALIE A

ART UNIT PAPER NUMBER

1642

DATE MAILED: 07/16/2002

13

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/441,723

Applicant(s)

HILLMAN ET AL.

Examiner

Natalie A. Davis

Art Unit

1642

*-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --***Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

1) Responsive to communication(s) filed on 26 March 2002.

2a) This action is FINAL.                    2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

4) Claim(s) 1,2 and 14-28 is/are pending in the application.

4a) Of the above claim(s) 15-28 is/are withdrawn from consideration.

5) Claim(s) \_\_\_\_\_ is/are allowed.

6) Claim(s) 1,2 and 14 is/are rejected.

7) Claim(s) \_\_\_\_\_ is/are objected to.

8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11) The proposed drawing correction filed on \_\_\_\_\_ is: a) approved b) disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.

12) The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) All b) Some \* c) None of:  
1. Certified copies of the priority documents have been received.  
2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.

14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) The translation of the foreign language provisional application has been received.

15) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

1) Notice of References Cited (PTO-892)                    4) Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.  
2) Notice of Draftsperson's Patent Drawing Review (PTO-948)                    5) Notice of Informal Patent Application (PTO-152)  
3) Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_.                    6) Other:

## **DETAILED ACTION**

1. The Group Art Unit examiner of the application has been changed. To aid in correlating any papers for this application, all further correspondence regarding this application should be directed to **Dr. Natalie A. Davis**.

2. Applicant's amendment filed 26 March 2002 (Paper No: 11) is acknowledged. Accordingly, claims 1, 14, 23 and 25 are amended, claims 1-2 and 14-28 are pending, claims 15-28 are withdrawn from examination as being drawn to a non-elected invention, and claims 1, 2, and 14 are under examination.

### ***Response to Arguments***

3. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

### ***Claim Rejections - 35 USC § 112 1<sup>st</sup> Withdrawn***

4. Rejection of claims 1 and 14 (paragraphs 3-5) under 35 U.S.C.112, first paragraph is withdrawn in view of amendments and arguments.

### ***Claim Rejections - 35 USC § 102 Withdrawn***

5. Rejection of claims 1 and 14 over Harris, et al. under 35 U.S.C. 102(b) is withdrawn in view of amendments.

### ***Claim Rejections - 35 USC § 102 Withdrawn***

6. Rejection of claims 1 and 14 over Hillier, et al. under 35 U.S.C. 102(a) is withdrawn in view of amendments.

Art Unit: 1642

***New Claim Rejections - 35 USC § 112***

7. Claims 1, 2, and 14 rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

Factors to be considered in determining whether undue experimentation is required, are summarized in *Ex parte Forman*, 230 USPQ 546 (BPAI 1986). They include the nature of the invention, the state of the prior art, the relative skill of those in the art, the amount of direction or guidance disclosed in the specification, the presence or absence of working examples, the predictability or unpredictability of the art, the breadth of the claims, and the quantity of experimentation which would be required in order to practice the invention as claimed.

The nature of the invention is to a protein comprising SEQ ID NO: 1. There are many polypeptides that encompass SEQ ID NO: 1 with an unlimited number of additional sequences.

This includes a whole universe of molecules that that may or may not perform the same biological functions and the specification does not give any guidance to which polypeptides comprising SEQ ID NO: 1 will exhibit biological activities as claimed. In addition, the claim does not recite what activity SEQ ID NO: 1 must possess. Thus, it would be an undue burden to one of ordinary skill in the art to assay for claimed sequences, which are capable of functioning as contemplated. One cannot extrapolate the teachings of the specification to the breadth of the claims because the claims are broadly drawn to any polypeptide comprising SEQ ID NO: 1 and applicant has not enabled all of these molecules because applicant has not been shown that these polypeptides are capable of functioning as that which is being disclosed. Thus, it would be an undue burden to one of ordinary skill in the art to assay for claimed sequences, which are capable of functioning as contemplated and one of ordinary skill in the art would not know how to make or use the invention as claimed.

8. Claims 1 (a), 2 and 14 are rejected under 35 U.S.C. 112, first paragraph. The instant specification does not contain a written description of the invention in such full, clear, concise, and exact terms or in sufficient detail that one skilled in the art can reasonably conclude that applicant had possession of the claimed invention at the time of filing.

*do not  
and make new  
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*Vas-Cath Inc. v. Mahurkar* (CA FC) 19 USPQ2d 1111 (6/7/1991) clearly states that "written description" of invention required by first paragraph of 35 U.S.C. 112 is separate and distinct from that paragraph's requirement of enabling disclosure, since description must do more than merely provide explanation of how to "make and use" invention; applicant must also convey, with reasonable clarity to those skilled in art, that applicant, as of filing date sought, was in possession of invention, with invention being, for purposes of "written description" inquiry, whatever is presently claimed. An applicant shows possession by describing the claimed invention with all its limitations using such descriptive means as words, structures, diagrams, and formulas. Also, description of an actual reduction to practice, or by showing the invention was "ready for patenting," or by describing distinguishing identifying characteristics sufficient to show that the applicant was in possession of the claimed invention at the time of filing.

The specification, while containing a written description for a polypeptide consisting of SEQ ID NO: 1, does not reasonably provide written description for a polypeptide comprising or having SEQ ID NO: 1. The disclosure does not indicate that applicant had possession of every polypeptide comprising SEQ ID NO: 1 with unknown sequence on either or both sides of SEQ ID NO: 1. There is no actual reduction to practice, sufficient descriptive information, such as definitive structural features, which are critical to polypeptide activity, or complete detailed description of the unknown sequence on either or both sides of SEQ ID NO: 1 indicating that the claimed polypeptides were indeed isolated, produced, and assayed for the uses disclosed. Thus, one skilled in the art would not recognize from the disclosure that the applicant was in possession of the claimed polypeptide.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Natalie A. Davis whose telephone number is 703-308-6410. The examiner can normally be reached on M-F 8-5:30 (every other Friday off).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Anthony Caputa PhD can be reached on 703-308-3995. The fax phone numbers for the organization where this application or proceeding is assigned are 703-308-4315 for regular communications and 703-308-4556 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0196.

Natalie Davis, PhD  
July 11, 2002

*C*  
ANTHONY C. CAPUTA  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 1600